

REMARKS/ARGUMENTS

Claims 1-33 are pending in this application. Reconsideration is respectfully requested.

I REJECTIONS UNDER 35 USC §102

The Examiner has rejected Claims 1-6, 10-12, 19-22, and 23-32 under 35 USC §102(e) citing U.S. Patent No. 7,069,333 issued to Morris (hereinafter “Morris”). The Examiner alleges that applicant’s claims are “clearly anticipated”. The rejection is respectfully traversed.

Applicant respectfully submits that the Examiner has not established a *prima facie* case of anticipation. The courts have explained: “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); and “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053(Fed. Cir. 1987).

It is respectfully submitted that a case of anticipation under 35 USC §102(e) has not been established since Morris does not disclose applicant’s invention. For example, Morris does not disclose, among other things, “collecting automatically, using such at least one Internet website client server, at least one fee from such at least one customer relating to such on-location electronics troubleshooting services”.

The Examiner alleges that Morris discloses the “automatic collecting” feature by pointing to Morris at Column 2, lines 34 to 38; however, it is respectfully submitted that this claimed feature is not disclosed here or *at all* in Morris. Morris at Column 2, lines 34 to 38, states, “The [technician-work-related] information is provided back to the service center where it 35 may be used to calculate the billing appropriate to the job being performed, or to keep the customer informed of the status of the technician's work”. Applicant respectfully submits that this is clearly *not* “collecting **automatically**, using such at least one Internet website client server, at least one fee from such at least one customer” (emphasis added). Further, other portions of

Morris confirm applicant's understanding that Morris does not collect payment automatically. For example, the below image is reproduced from page 385 of the Morris's prior provisional filing (Application Serial No. 60/148,798) incorporated by reference into Morris.

The following fields are used the Bill To Customer data entry form.

Fieldname	Description
Company Name	Company name of the selected billing entity.
Address	Street address of the selected billing entity.
When to Bill	When to bill the selected customer. For example, monthly on the 15 th , monthly on the 1 st , upon completion of the job, etc.
Attn	Bills should be sent to the attention of this person or group.
Dept/ Care Of	Name that bills are to be sent in care of.

Table 34: Job Site Billing Info Tab Bill to Customer Data Entry Fields

Applicant respectfully notes that the "When to Bill" fieldname does not say "collect automatically". On the contrary, it is clear that the system of Morris is intended to use traditional billing/invoicing. Further, the above image also clearly proves, by virtue of the text, that bills are sent/mailed for payment; payment is *not* collected automatically as applicant claims.

Returning to Morris, Morris at column 6, lines 54-56 states that the customer "may have a relationship where they pay a fee for on-call service, or they may simply pay for work performed as it is needed." Applicant respectfully submits that, in view of the other factual evidence submitted, that this "payment" is received after invoicing/billing the customer. Once again, the payment is *not* automatically collected.

Applicant respectfully submits that the claimed invention, which includes, among other things, automatically collecting payment, provides many commercially significant advantages. For example, knowing that payment is collected automatically benefits the troubleshooter in that worrying about payment issues is removed. Further, for the customer, automatic payment is a significant convenience in that it diminishes the chance that a past due bill will damage a customer's credit or delay troubleshooting services. Further, automatic payment provides the

system provider with steady cash flow for necessary software, hardware, and wetware (e.g., human technicians).

With respect to Claim 2, the Examiner cites Morris at column 14, lines 48-55, which states, “This map may optionally be linked to a locator service 50 which allows the system to determine the location of the technician system and thereby display a more useful map. For instance, if the technician system is located 30 miles from the job site, a map which is zoomed out to a large scale may be the most appropriate display for leading the technician to the job site. Conversely, when the technician system is located within a mile of the job site, a map of smaller scale showing individual streets may be displayed to guide the technician directly to the proper address.” Applicant respectfully submits that this portion of Morris is directed to providing a map *not* a system “wherein such at least one customer and such at least one technician are sufficiently co-located within geographical areas to provide appropriate response times” which applicant claims. Applicant’s claimed invention provides the advantage of quick response times by the troubleshooter. Applicant’s provision of a map for the benefit of the technician is a separate issue. While this distinction is subtle, applicant respectfully submits that the Examiner has not established a *prima facie* case of anticipation with respect to Claim 2.

With respect to Claim 3, the Examiner cites FIG. 8b as allegedly disclosing applicant’s claimed invention. Applicant respectfully submits that “total time” worked in a 40 hour work period (what is disclosed in FIG. 8b) is *not* equivalent to the start time or end time (which provides historical time significance for record keeping purposes). Since this identical feature is apparently missing in Morris, applicant respectfully submits that the Examiner has not established a *prima facie* case of anticipation with respect to Claim 3.

With respect to Claim 5, applicant submits that a customer satisfaction evaluation is markedly different than a review of a work order which Morris discloses at column 13, lines 25-30. The purpose of Morris’ work order review is for the technician and the customer to verify the accuracy of the information contained within the work order primarily for *proper billing*. The purpose of applicant’s customer satisfaction evaluation is to gather data primarily related to the customer’s level of satisfaction. These are very different goals, and as such, applicant

respectfully submits that the Examiner has not established a *prima facie* case of anticipation with respect to Claim 5.

With respect to Claim 6, the “payment” discussed in Morris is not collected automatically as discussed above.

With respect to Claims 10 and 11, the Examiner cites FIG. 4 and column 19, lines 43-55. Applicant respectfully submits that Morris does not disclose notifying a customer of the estimated time of arrival (*i.e.*, prior to arriving). Morris clearly relates to events after completion of the work in that at column 19, lines 43-55, Morris states, “The Work Order Summary is a listing which is *generated* based upon all of the recorded information *produced* and 45 *recorded* upon the technician system at the job site. This produces a line-by-line summary which includes such information as the time of arrival of the technician to the job site, the name of each piece of equipment inspected, the specific measurements *made* and the values of the readings *taken* for 50 that equipment, the diagnostic activity *performed*, the maintenance tasks *performed*, and the replacement parts *ordered*, if any. This information is listed for each piece of equipment which was *worked* on. Additionally, any notes *entered* by the technician in the “Notes” screens will be entered here as 55 well” (emphasis added). Applicant respectfully stresses Morris’s use of the *past tense* verb tense (e.g., generated, produced, recorded, taken, made, performed, ordered, etc.).

With respect to Claim 12, applicant’s claimed invention states “any time of day” which includes those hours outside of typical business hours. Morris shows dates and times that range between 8:00am and 5:00pm, typical business hours.

With respect to Claim 16, Morris clearly does not disclose certifying technicians as applicant claims. Morris at column 11, lines 5-15 only discusses technicians providing billing rate and employee ID number. Further, neither FIG. 2 nor FIG. 3 of Morris show anything remarkable pertaining to Claim 16.

With respect to Claim 17, Morris does disclose applicant’s claimed invention. For example, Morris does *not*, among other things, identify and assign a technician having the greatest elapsed

time since the last notification. Morris clearly states that an “available” technician is sent (Morris at column 11, lines 49-50). Applicant’s system is commercially significant in that it provides a system, in combination with other claimed elements, to systematically divide work among a group of troubleshooters tending to a wide variety of jobs.

With respect to Claim 20, Morris does *not* teach that a troubleshooter can use applicant’s claimed system to, without supervision, schedule their own work shift. Similarly, with respect to Claim 21, Morris does *not* teach presenting an “alternate” work shift schedule to a technician as applicant claims (presenting a “planned shift scheduling” to a technician).

With respect to Claim 4, 17, and 22 applicant respectfully submits that viewing Morris does not disclose these claimed limitations.

With respect to Claims 23-32, the Examiner rejects them using the same analysis applied to essentially Claims 1-22. Applicant incorporates by reference applicant’s above remarks and arguments with respect to Claims 23-32.

Applicant respectfully requests withdrawal of the rejections.

II REJECTIONS UNDER 35 USC §103

The Examiner has rightly determined that Claims 7-9, 13-15 and 18 are novel. The only remaining issue with respect to Claims 7-9, 13-15 and 18 is whether these claims are “obvious”. The Examiner has rejected Claims 7-9, 13-15 and 18 under 35 USC §103(a) as allegedly being “obvious” in view of Morris and Official Notice.

Applicant has shown above that Morris is not an anticipating reference since it does not teach applicant’s claimed elements. Claims 7-9, 13-15, and 18 depend either directly or indirectly to Claim 1. Applicant respectfully submits that, since Claim 1 is not anticipated or rendered obvious by Morris, the rejection of Claims 7-9, 13-15, and 18 is moot. “If an independent claim

is nonobvious under 35 USC §103, then any claim depending therefrom is nonobvious.” *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Applicant further respectfully submits that any “obviousness” rejection supported by a single reference and the Examiner’s “Official Notice”—after the Examiner has knowledge of the claimed invention and has had much time to study applicant’s teachings and drawings—must be made based on impermissible hindsight. MPEP 2142. “It is difficult but necessary that the decisionmaker *forget what he or she has been taught . . . about the claimed invention* and cast the mind back to the time the invention was made (often as here many years), to occupy the mind of one skilled in the art...” *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984) (emphasis added).

Applicant respectfully submits that the Examiner has not established a *prima facie* case of obviousness. The Examiner bears this burden. MPEP 2142. Applicant respectfully submits that the Examiner is not focusing on the claim *as a whole*, per 35 USC §103, and is focusing too much attention to the words “credit card”. Applicant respectfully submits that it is claiming in Claim 7, for example, “authorizing at least one charge to such credit card account of such at least one customer” in addition to the other 14 limitations of Claims 7 and 1 (the parent claim). “*All words* in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) (emphasis added).

Applicant respectfully asks that the Examiner reconsider the “obviousness rejections” made in this case. As a technically-minded person, the Examiner should appreciate that studies have been conducted showing that most “obviousness” analyses are wrongfully decided. Specifically, these studies have statistically determined that the study participants “who were not informed of the invention were substantially more likely to judge a solution non-obvious than participants who were informed what the invention was... *Ex post knowledge of invention deeply affected participants’ conclusions regarding whether an invention was non-obvious ex ante*”. Gregory N.

Mandel, Patently Non-Obvious: Empirical Demonstration that the Hindsight Bias Renders Patent Decisions Irrational, 67 Ohio St. L.J. 1391, 1411 (2006) (emphasis added).

Lastly, to rebut the Examiner's Official Notice findings, applicant respectfully submits the following comments. MPEP 2144.03 states, "In certain circumstances where appropriate, an examiner may take official notice of facts not in the record or rely on "common knowledge" in making a rejection, however such rejections should be judiciously applied." Applicant agrees that using a credit card *today* is common practice to purchase goods. However, with respect to services, applicant respectfully disagrees, at least without documentary or sufficient evidence in the record. Applicant further respectfully submits that the Examiner's declaration of Official Notice is in error. For example, the cited reference, Morris, does teach or hint at using credit card payments. Applicant respectfully requests that—only if the Examiner is not persuaded to issue a Notice of Allowance in this matter—that the Examiner provide some sort of documentary evidence, pursuant to MPEP 2144.03, that in the field of repair service and troubleshooting that, at the time the invention was made, sending information over the Internet, in combination with applicant's other claimed limitations would have been "obvious". Applicant notes that the standard of review applied to findings of fact is the "substantial evidence" standard under the Administrative Procedure Act (APA). See *In re Gartside*, 203 F.3d 1305, 1315, 53 USPQ2d 1769, 1775 (Fed. Cir. 2000).

In light of the above comments, applicant requests reconsideration of the rejections based on "obviousness".

III CONCLUSION

For the reasons advanced above, applicant respectfully submits that the application is in condition for allowance. Applicant respectfully solicits a notice of allowance from the Examiner in this matter.